

**REMARKS**

By this amendment, Applicants propose to amend claims 1, 10, 24, and 31, cancel claims 25-27 without prejudice or disclaimer, and add new claims 32-34. No prohibited new matter has been added. Upon entry of this amendment, claims 1-10, 16-24, and 28-34 will be pending.

In the Final Office Action of September 22, 2008<sup>1</sup>, the Examiner rejected claims 1-10 and 16-31 under 35 U.S.C § 103(a) as being unpatentable over U.S. Patent No. 6,058,413 to Flores ("Flores") in view of U.S. Published Patent Application No. 2005/0177507 to Bandych et al. ("Bandych").

Applicants respectfully traverse the rejection of claims 1-10 and 16-31 under 35 U.S.C § 103(a) as being unpatentable over *Flores* in view of *Bandych*. A *prima facie* case of obviousness has not been established. Because claims 25-27 are cancelled, the rejection of these claims is moot.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "In determining the

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<sup>1</sup> As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include] [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1 recites a method for automatically filing documents relating to business transactions using a computer system, including “generating an output header for the output data record, the output header including the general data from the input header,” “reading additional data, relating to the business transaction, from a database application,” and “adding the additional data to the output header.” On page 3 of the Final Office Action, the Examiner concedes that *Flores* does not disclose the claimed “output data record,” and instead relies on *Bandych*. Applicants respectfully traverse the rejection because *Bandych* does not overcome the deficiencies of *Flores*.

With respect to Figure 10, *Bandych* discloses various collaborative back offices (CBOs) that send data to trade engine 182 via trade integration module 192. Trade integration module 192 “pulls data from the CBO system and provides data conversion . . . to communicate the data to the central trade engine 182.” *Bandych*, ¶ [0121].

However, *Bandych*'s converted data does not include an "output header" nor does *Bandych* teach or suggest "reading additional data, relating to the business transaction, from a database application," and "adding the additional data to the output header," as recited in claim 1 (emphasis added).

Moreover, the Examiner further alleges that *Bandych*'s converted data teaches or suggests "formatting a first data area of the output data record, such that the first data area is compatible with a first business application," and "formatting a second data area of the output data record, such that the second data area is compatible with a second business application." Specifically, the Examiner alleges that *Bandych*'s converted data provided to trade engine 182 from trade integration module 192 must include "a first data area" and "a second data area," in order to be compatible with the multiple buyers and sellers in Figure 10 of *Bandych*. This is not correct.

*Bandych*'s CBO system is "generic to all buyers and seller." *Bandych*, ¶ [0121] (emphasis added). Accordingly, *Bandych*'s converted data is formatted generically for the generic CBO system, and not specifically for different buyers and sellers. Because of its generic formatting, *Bandych*'s converted data does not include "a first data area . . . compatible with a first business application," and "a second data area . . . compatible with a second business application," as recited in claim 1.

Indeed, it is because of the generic nature of *Bandych*'s converted data that *Bandych* further discloses customer adaptor 194 to provide "customer specific alterations" from the generic CBO system to the specific buyer or seller. *Bandych*, ¶ [0121]. *Bandych*'s customer adaptor 194 would not be necessary if *Bandych*'s converted data included "a first data area . . . compatible with a first business

application," and "a second data area . . . compatible with a second business application," as recited in claim 1.

For at least these reasons, *Flores* and *Bandych* fail to teach or suggest all elements of claim 1, and the § 103 rejection should be withdrawn.

In view of the failure of the prior art to teach or suggest a combination including the elements of claim 1 discussed above, the Office Action has failed to properly determine the scope and content of the prior art and to properly ascertain the differences between the prior art and the claimed invention. Thus, the Office Action has failed to clearly articulate a reason why the claims would have been obvious to one of ordinary skill, in view of the prior art. Accordingly, no *prima facie* case of obviousness has been established, and the Examiner should withdraw the rejection of independent claim 1 under 35 U.S.C § 103(a).

Independent claims 10, 24, and 31 while of different scope than claim 1, are patentable over *Flores* and *Bandych* for at least similar reasons to that presented above for claim 1. Claims 2-9, 16-23, and 28-30 are patentable over *Flores* and *Bandych* at least due to their dependence from one of claims 1, 10, and 24. New claims 32-34 are also patentable over *Flores* and *Bandych* at least due to their dependence from one of claims 1, 10, and 24.

### CONCLUSION

Applicants respectfully request that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing the pending claims in condition for allowance. Applicants submit that the proposed amendments do not raise new issues or necessitate the

undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

In view of the foregoing, Applicants submit that the amended claims are neither anticipated nor rendered obvious in view of the cited references. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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By: \_\_\_\_\_

  
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